

HONORABLE JAMES L. ROBERT

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

MICROSOFT CORPORATION,
Plaintiff,
v.
MOTOROLA, INC., et al.,
Defendants.

No. C10-1823-JLR

REDACTED

JOINT NOTICE OF RULING IN
RELATED CASE AND MOTION TO
SUPPLEMENT THE RECORD ON
SUMMARY JUDGMENT

Noted For: May 4, 2012

MOTOROLA MOBILITY, INC., et al.,
Plaintiffs,
v.
MICROSOFT CORPORATION,
Defendant.

Microsoft Corporation ("Microsoft") and Motorola, Inc. (nka Motorola Solutions, Inc.),
Motorola Mobility, Inc., and General Instrument Corporation (collectively "Motorola") hereby
provide notice of rulings in two related disputes between certain of the parties. Specifically,
attached hereto as Exhibit 1 is a copy of the Initial Determination issued by Administrative
Law Judge David P. Shaw on April 23, 2012 (the "Initial Determination") in *In the Matter of*

JOINT NOTICE OF RULING
IN RELATED CASE AND MOTION TO
SUPPLEMENT THE RECORD - I

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1 *Certain Gaming and Entertainment Consoles, Related Software, and Components Thereof*,
 2 ITC Investigation No. 337-TA-752 (the "ITC Action").¹

3 In the ITC Action, Motorola Mobility, Inc. and General Instrument Corp. asserted that
 4 Microsoft's Xbox 360 game console and certain accessories infringe five of its patents
 5 (US 6,069,896; US 7,162,094; US 6,980,596; US 5,357,571; and US 5,319,712). On that
 6 basis, Motorola has sought an exclusion order barring import of such products into the United
 7 States.

8 Four of the patents at issue in the ITC Action are also the subject of Microsoft's
 9 affirmative claims in this action.² Those four patents are asserted by Motorola to be essential
 10 to implementation of either the ITU's H.264 video compression standard (US 7,162,094 and
 11 US 6,980,596) or the IEEE's 802.11 wireless communication standard (US 5,357,571 and
 12 US 5,319,712). The Parties believe the Initial Determination is relevant to the issues currently
 13 before the Court on summary judgment due to ALJ Shaw's analysis relating to overlapping
 14 standard-essential patents and Microsoft's RAND-related equitable defenses.

15 Microsoft believes that the most relevant passages from the Initial Determination can
 16 be found in the ALJ's analysis on pages 300-303.

17 Motorola believes that the most relevant passages can be found in the ALJ's
 18 conclusions of law on pages 330-31.

19 Attached hereto as Exhibit 2 is a copy of the May 2, 2012 decision in *General*
 20 *Instrument Corp. v. Microsoft Deutschland GmbH*, Case No. 2 O 240/11, which was pending
 21 in Mannheim, Germany. This proceeding involved the assertion of two German patents
 22 assigned to General Instrument Corp. that were listed in Motorola's offer to Microsoft. The

23 _____
 24 ¹ The Initial Determination is being filed under seal, pursuant to the Parties' Stipulated Motion to File ITC Initial
 Determination Under Seal.

25 ² The fifth patent (US 6,069,896) is also the subject of Microsoft's claims in this action, but was asserted against
 non-essential functionality in the ITC Action

German court's decision can be made public at the parties' discretion and is in the process of being translated by both Motorola and Microsoft.

The portion of the German court's opinion that may have relevance to the proceedings in this Court can be found at pages 36-49 of Exhibit 2, as translated in Exhibit 3 (Motorola's preliminary translation of pages 36-49) and Exhibit 4 (Microsoft's preliminary translation of the opinion³). The parties will file certified copies of their translations of the entire opinion as soon as those translations are complete.

Accordingly, the parties jointly move to supplement the record on their pending motions for summary judgment (Docket Nos. #141, #228 and #237), scheduled for hearing on May 7, 2012.

DATED this 4th day of May, 2012.

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³ Exhibit 4 is a translation of the May 2, 2012 opinion issued by the German court in *General Instrument Corp. v. Microsoft Corp. and Microsoft Ireland Operations Limited*, Case No. 2 O 387/11, which has been consolidated with Case No. 2 O 240/11. The substance of the two German orders is materially the same with respect to any issues potentially relevant to this matter. The passage at pages 36-49 of Exhibit 2 corresponds to pages 20-33 of Exhibit 4.

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EXHIBIT 1
FILED
UNDER SEAL